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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/610,768	07/06/2000	William P. Alberth JR.	CS10557	5526

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EXAMINER

TRAN, TUAN A

ART UNIT PAPER NUMBER

2682

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/610,768

### Applicant(s)

ALBERTH ET AL.

### Examiner

Tuan A Tran

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-10,14-24,27 and 30 is/are allowed.
- 6) ☒ Claim(s) 1,2,4,11-13,26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-2, 13, 26 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5,742,666) in view of Nichols (5,109,525).

Regarding claims 1-2 and 13, Alpert discloses a method of sending a message stored in memory associated with a wireless device 54 (See fig. 3A), the wireless device 54 including a microphone 60, the method comprising the steps of: initiating a call from the wireless device (See fig. 3A and col. 3 lines 36-41, col. 5 lines 12-15); sending the stored message from the wireless device and sending position data from the wireless device after a call is established (See col. 5 lines 15-20, col. 5 line 55 to col. 6 line 5); and terminating sending the stored message when a key of the wireless device is activated (See col. 5 lines 20-23, col. 6 lines 43-49, col. 10 lines 40-46).. However, Alpert does not mention the step of sending the stored message when a predetermined time has elapsed on a timer wherein the timer is initiated when the call is established. Nichols teaches a two-way radio with voice storage (See fig. 1) wherein a timer 25 is applied to delay operational execution such as checking channel availability before transmission of stored message (See figs. 1-2 and col. 3 lines 23-33, col. 4 lines 43-47).

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Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of timer function of Nichols in delaying to send the stored message to the receiving party from the wireless device as disclosed by Alpert for the advantage of minimizing inadvertent or mistaken service request.

Claims 26 and 29 are rejected for the same reasons as set forth in claim 1, as apparatus.

2. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5,742,666) in view of Nichols (5,109,525) as applied to claim 26 above, and further in view of JP 08251313.

Regarding claim 28, Alpert & Nichols discloses as cited in claim 26. However, they do not mention the controller if further program to terminate transmission of the stored message when a voice signal is picked-up by a microphone of the wireless device. JP 08251313 suggests an apparatus 1 capable of transmitting an audio signal and a data signal to a transmission line wherein the apparatus stops transmission of data signal when the audio signal is detected by a tone voice detector (See fig. 1 and the English Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the suggestion of JP 08251313 in modifying the wireless device as disclosed by Alpert & Nichols such that the device stops transmission of the stored message when audio signal (voice signal) is detected for the advantage of allowing the user to speak directly to the called party when the user is capable.

3. Claims 4 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5,742,666) in view of JP 08251313.

Regarding claims 4 and 12, Alpert discloses a method of sending a message stored in memory associated with a wireless device 54 (See fig. 3A), the wireless device 54 including a microphone 60, the method comprising the steps of: initiating a call from the wireless device (See fig. 3A and col. 3 lines 36-41, col. 5 lines 12-15); sending the stored message from the wireless device after a call is established (See col. 5 lines 15-20). However, Alpert does not mention the steps of monitoring the microphone for audio signals and terminating sending the stored message when an audio signal is picked-up by the microphone of the wireless device. JP 08251313 suggests an apparatus 1 capable of transmitting an audio signal and a data signal to a transmission line wherein the apparatus stops transmission of data signal when the audio signal is detected by a tone voice detector (See fig. 1 and the English Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the suggestion of JP 08251313 in reconfiguring the wireless device as disclosed by Alpert with the tone voice detector such that the device stops transmission of the stored message when an audio signal (a voice signal) is detected for the advantage of allowing the user to speak directly to the called party when the user is capable.

4. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alpert (5,742,666) in view of Ebata et al. (6,487,542).

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Regarding claim 11, Alpert discloses a method of sending a message stored in memory associated with a wireless device 54 (See fig. 3A), the wireless device 54 including a microphone 60, the method comprising the steps of: initiating a call from the wireless device (See fig. 3A and col. 3 lines 36-41, col. 5 lines 12-15); sending the stored message from the wireless device after a call is established (See col. 5 lines 15-20). However, Alpert does not mention that the data message including a digital signature. Data message having digital signature is well known in the art as suggested by Ebata (See col. 10 lines 5-11). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included digital signature, as Ebata's suggestion, into the transmitted data message as disclosed by Alpert in order to enhance the validity of the message.

***Allowable Subject Matter***

5. Claims 5-10, 14-24, 27 and 30 are allowed.

The following is an examiner's statement of reasons for allowance:

The reasons for allowance of claims 5-10, 14-24, 27 and 30 have been indicated in Office Actions mailed on 04/23/2003 and 10/09/2003 respectively.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

Applicant's arguments filed 11/08/2004 have been fully considered but they are not persuasive.

a. The Applicant argued that Nichols fails to make up for the deficiencies of Alpert in attempting to known or obvious (See Remark, page 8). The Examiner respectfully disagrees with the Applicant's argument because Alpert teaches all the claimed limitation except the delay of transmission of the prerecorded message (See above rejection for details). However, the technique of delaying executing a particular operation for a particular purpose is common in the art as shown by Nichols, Nichols teaches a two-way radio with voice storage (See fig. 1) wherein a timer 25 is applied to delay operational execution such as checking channel availability (the particular purpose) before transmission of stored message (See figs. 1-2 and col. 3 lines 23-33, col. 4 lines 43-47); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of timer function of Nichols in delaying to send the stored message to the receiving party from the wireless device as disclosed by Alpert for the advantage of minimizing inadvertent or mistaken service request. For that reasons, the Examiner remains the same rejections for the pending claims.

b. The Applicant argued that Tanaka does not terminate the sending or not send the stored message (See Remark, page 9, second paragraph). The Examiner respectfully disagrees with the Applicant because by stopping the transmission of data signal when the audio signal is detected (See above rejection for details), Tanaka does

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terminate or not send (either temporarily or permanently) the transmission of the stored message. Tanaka does disclose the claimed subject matter based on the language of the claims.

c. The Applicant argued that the Examiner has failed to provide any motivation in combination Alpert with Ebata. The Examiner respectfully disagrees with the Applicant's argument because motivation to combine Alpert and Ebata has been provided (See rejections).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan Tran** whose telephone number is **(703) 605-4255**.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vivian Chin**, can be reached at **(703) 308-6739**.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**


**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

  
Tuan Tran

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**VIVIAN CHIN**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600